

REMARKS

Claims 1-51 are pending in this application, of which claims 19-51 have been withdrawn from further consideration.

(1) Claims 1-4, and 8-12 stood rejected under 35 U.S.C. 102(a)/102(e) as being anticipated by Matyjaszewski et al. (U.S. 5,763,548).

Claim 1 recites "a compound (I) having a functional group and an internal alkenyl group." That is, the claimed production method uses a compound (I) having both of a functional group and an internal alkenyl group, which Matyjaszewski et al. do not disclose. So, the rejection of claims 1-4 and 8-12 under 35 U.S.C. 102(a)/102(e) is not supported by Matyjaszewski et al.

This argument was made in the previous Applicants' Response filed on June 5, 2003, page 3, section (3), but it is repeated because the "Response to Arguments" of the outstanding Office Action does not respond to the Applicants' argument. Please note that the Applicants' Argument of the non-enablement filed on June 5, 2003 was only directed to the rejection of claims 13-18.

Applicants request to reconsider the rejection of claims 1-4 and 8-12.

(2) Claims 13-18 stood rejected under 35 U.S.C 102(a,e,b) as anticipated by or, in the

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alternative, under 35 U.S.C. 103(a) as obvious over Matyjaszewski.

Applicants argued in the previous Response that the scheme of Example 23 of Matyjaszewski et al. was not enabling. Applicants supplement the detailed reason of the argument.

Example 23 of Matyjaszewski et al. discloses that HBr abstraction of a telechelic PMMA with two Br end groups, produced in Example 22. The polymerization of methyl methacrylate (MMA) in Example 22 is disclosed according to Example 3. In Examples 22 and 3, there is no disclosure of any monomers other than methyl methacrylate. Thus, the polymerization of methyl methacrylate (MMA) according to the procedure of Example 3 only produces a polymer having a terminal of $-\text{CH}_2-\text{C}(\text{CH}_3)(\text{COOCH}_3)\text{Br}$.

Therefore, the formula disclosed in Example 23, $\text{Br}-\text{CH}_2\text{CH}_2-\text{Pn}-\text{CH}_2\text{CH}_2-\text{Br}$, is an error, which should be shown as $-\text{C}(\text{CH}_3)(\text{COOCH}_3)\text{Br}-\text{CH}_2-\text{Pn}-\text{CH}_2-\text{C}(\text{CH}_3)(\text{COOCH}_3)\text{Br}$. Even if HBr abstraction is carried out on the above formula, $-\text{C}(\text{CH}_3)(\text{COOCH}_3)\text{Br}-\text{CH}_2-\text{Pn}-\text{CH}_2-\text{C}(\text{CH}_3)(\text{COOCH}_3)\text{Br}$, it is impossible to prepare a polymer having a terminal or internal alkenyl group. Thus, the scheme of Example 23 in Matyjaszewski et al. is not enabling.

Since a reference cannot anticipate a claim if the reference would not enable one skilled in

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the art to make the claimed invention without undue experimentation, Matyjaszewski et al. cannot deny the patentability of the invention of claims 13-18.

(3) Claims 1-4 and 8-18 were rejected under 35 U.S.C. 102(b) as anticipated by, or under 35 U.S.C. 103(a) as obvious over EP'469, which corresponds to U.S. 6,455,645.

This application is based on an International Application PCT/JP00/00452 filed on January 28, 2000, which claims priorities of Japanese Application Nos. 11/19744 and 11/19745, both filed on January 28, 1999, in which the present invention is described. Applicants submit the translations of the Applications.

Therefore, the present invention antedates the published date of EP'469, September 29, 1999, and the US filing date of U.S. 6,455,645, March 18, 1999. Reconsideration of the rejection is respectfully requested.

In view of the aforementioned amendments and accompanying remarks, claims 1-18 are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number

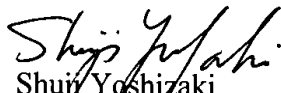
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indicated below to arrange for an interview to expedite the disposition of this case. The limited recognition of the agent is attached.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Shuji Yoshizaki
Agent for Applicants
Limited Recognition

Attachment: Translation of Japanese Applications Nos. 11/19744 and 11/19745
Limited Recognition

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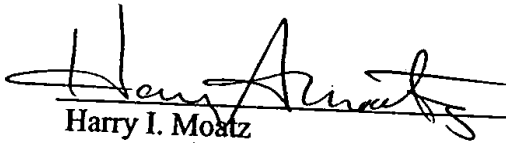
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Expires: July 8, 2004


Harry I. Moatz
Director of Enrollment and Discipline